

REMARKS

Applicant has carefully reviewed the Application in light of the Final Office Action mailed January 13, 2005. At the time of the Office Action, Claims 1-48 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-40, 43-44, and 48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,491 issued to Chang et al. (hereinafter "*Chang*") in view of U.S. Patent No. 6,167,268 issued to Souissi et al. (hereinafter "*Souissi*"). The Examiner rejects Claims 41 and 42 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 6,246,875 issued to Seazholtz, et al. (hereinafter "*Seazholtz*"). The Examiner rejects Claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 5,613,199 issued to Yahagi (hereinafter "*Yahagi*"). The Examiner rejects Claim 46 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 6,115,582 issued to Ishida (hereinafter "*Ishida*"). The Examiner rejects Claim 47 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 6,278,877 issued to Brederveld et al. (hereinafter "*Brederveld*"). These rejections are respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>1</sup> It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on,

---

<sup>1</sup> See M.P.E.P. §2142-43.

at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, Independent Claim 1 recites a method for detecting a wireless network that includes “scanning for the specified network in response to at least determining that the mobile device is within the coverage area of the specified network, wherein a decision as to whether to scan, by the mobile device, for the specified network is based on a distance between the location of the mobile device and a location of the specified network.” The Examiner has not identified a relevant portion of *Chang* to support these elements.

At the passage cited by the Examiner in the recent Advisory Action for these elements, *Chang* provides: “When the radiotelephone powers up or enters the coverage area of a public system base station, it obtains the supported User Zone IDs from the paging channel. If the radiotelephone finds a User Zone ID match with those stored in the radiotelephone, the radiotelephone attempts to locate the User Zone using the broadcast location information parameters. These parameters, in an alternate embodiment, could have been stored in the radiotelephone's memory along with the User Zone ID. In this embodiment, the serving base station would only broadcast the User Zone IDs of the User Zones within its service area. If the radiotelephone determines that it is within the boundaries of a particular User Zone (705 or 706), it displays the alphanumeric tag associated with that User Zone (705 or 706). The radiotelephone then registers with the User Zone (705 or 706).” (See *Chang*: Columns 7-8, lines 65-15.)

Hence, in *Chang* there appears to be no scanning decision: much less one that is based on a distance between the location of the mobile device and a location of the specified network, as is clearly recited in Independent Claim 1. Registration is not the same as a scanning operation that is performed based on a location. Hence, *Chang* fails to anticipate this element and, thus, cannot inhibit the patentability of the pending claims.

*Souissi* fails to offer anything that is combinable with *Chang* that would be material to patentability. The Examiner agrees with Applicant that *Souissi* is simply out of place in such a §103 analysis. (See recent Advisory Action.) In particular, *Souissi* provides a distance evaluation: but an evaluation that is not within the environment of determining whether the mobile device is within a coverage area of a specified network based on the data and scanning for the specified network in response to at least determining that the mobile device

is within the coverage area of the specified network, wherein a decision as to whether to scan, by the mobile device, for the specified network is based on a distance between the location of the mobile device and a location of the specified network, as is recited in Independent Claim

1. For at least this reason, any usage of *Souissi* is improper.

It is also noted that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Chang* reference or of the proposed *Chang-Souissi* or *Chang-Souissi-Seazholtz* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Chang*, *Souissi*, or in *Seazholtz*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>2</sup> Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>3</sup>

Nothing in *Chang*, *Souissi*, or in *Seazholtz* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>4</sup> This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.<sup>5</sup> guidelines and governing Federal Circuit case law.<sup>6</sup> The M.P.E.P. consistently

---

<sup>2</sup> M.P.E.P. §2143.01 (emphasis in original).

<sup>3</sup> *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>4</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

<sup>5</sup> See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

<sup>6</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion,

confirms that this approach is improper and, thus, it should not be used here.<sup>7</sup> Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”<sup>8</sup> Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”<sup>9</sup>

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness.

Accordingly, Independent Claim 1 is patentable over *Chang*, *Souissi*, and *Seazholtz* for at least these reasons. Additionally, Independent Claims 14, 27, and 40 include a similar limitation to that identified above and, thus, are also allowable over *Chang*, *Souissi*, and *Seazholtz* for similar reasons. In addition, the corresponding dependent claims associated with these Independent Claims are also patentable over these references for analogous reasons. Notice to this effect is respectfully requested.

---

teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

<sup>7</sup> See M.P.E.P. §2145.

<sup>8</sup> See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

<sup>9</sup> See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

ATTORNEY DOCKET NO.  
062891.0515

PATENT APPLICATION  
09/839,832

15

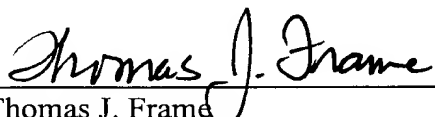
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

  
\_\_\_\_\_  
Thomas J. Frame  
Reg. No. 47,232

Date: March 8, 2005

Correspondence Address:

Customer No. **05073**